

REMARKS/ARGUMENTS

The Final Office Action

In the above-mentioned final Office Action, the specification was objected to, claims 331, 355, 378, 401 and 431 were rejected as failing to comply with the written description requirement, claims 314, 316-320, 325, 330-332, 336-339, 341-344, 349, 354-356, 361-367, 372, 376-379, 383, 385-390, 395, 400-402, 406, 408-416, 418-425 and 430-437 were rejected as being unpatentable over U.S. Patent 5,462,488 (McKillip), claims 315, 321-324, 333-335, 340, 345-348, 357-359, 368-371, 380-382, 384, 391-394, 403-405, 407 and 417 were rejected as being unpatentable over McKillip in view of U.S. Patent 5,407,718 (Popat); claims 328, 398, 428 and 429 were rejected as unpatentable over McKillip in view of U.S. Patent 5,622,758 (Hollis); and claims 326, 327, 350, 351, 373, 374, 396, 397, 426 and 427 were rejected as unpatentable over McKillip in view of U.S. Patent 4,703,317 (Hickenbotham).

Specification Amendment

In response to the final Office Action, the specification has been amended to delete the text added to paragraph [0096] in the Amendment filed February 21, 2008 and objected to as adding new matter. This objection is now moot.

Claim Amendments

In the final Office Action, claims 331, 355, 378, 401 and 431 were rejected under 35 U.S.C. § 112, first paragraph. In response, Applicants have cancelled these claims without prejudice or disclaimer. Thus, these rejections are now moot.

Additionally, new dependent claim 438 is added. It includes the features of dependent claims 341, 345 and 356.

Requirements of an Obviousness Rejection under 35 U.S.C. §103

Many of the obviousness rejections in the subject final Office Action, as discussed in detail in subsequent sections of this Amendment, are defective for the reasons discussed in the following two paragraphs which summarize the state of the law.

The failure of an asserted combination to teach or suggest *each and every feature of a claim* is fatal to an obviousness rejection under 35 U.S.C. § 103. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). (Emphasis added.) Indeed, as the Board of Patent Appeals and Interferences has confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). (Emphasis in original.) Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (emphasis added). Indeed, Applicants submit that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “*the invention as described and claimed*.” (Emphasis added.) Lastly, Applicants respectfully direct the examiner’s attention to MPEP §2143, whose instructions buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In sum, it is well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Defective Action

The final Office action is defective because it fails to comply with 37 CFR 1.104(c)(2) which states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Additionally, MPEP 707.07(f) states “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.” (Emphasis added.) And referring to ¶ 7.37, the Examiner's response must be: “Applicant's arguments filed [The examiner **must** address all arguments which have not already been responded to in the statement of the rejection.] have been fully considered but they are not persuasive [and provide explanation as to non-persuasiveness].” (Emphasis Added.) The examiner in this final Office Action has not addressed all arguments and has not provided explanations for her obviousness rejections.

Although it is clear that the final Office action fails to satisfy the rules and the MPEP, to avoid further delays, aspects of the §103 rejection are addressed below.

Rejection of Independent Claim 413 Over McKillip is Defective and Must be Withdrawn

The rejection of independent claim 413 is defective and incomplete and must be withdrawn. This defect was pointed out to the examiner in Applicants' last response, and the examiner did not correct or even address this error in the subject final Office Action. Specifically, claim 413 includes

“a weakened fold line in the cardstock sheet construction and across the one of the at least one printable and foldable card.” (Emphasis added.) It further states that “the separate printed and foldable card being foldable on the fold line.” (And dependent claim 414 says that this “fold line is a score line.”) The final Office Action does not state where McKillip discloses this “weakened fold line,” that McKillip has this weakened fold line or where there was a suggestion for adding this weakened fold line. Accordingly, withdrawal of this rejection is in order.

Rejections of Independent Claims 363 and 387 Are Defective and Must Be Withdrawn

The rejections of claims 363 and 387 are defective and incomplete and must be withdrawn, Applicant respectfully contends. This defect was pointed out to the examiner in Applicant’s last response, and the examiner did not correct or even address these errors in this final Office Action. Specifically, independent claim 363 includes “a primer coat between the ultraremovable adhesive and the liner sheet,” and independent claim 387 includes that the liner sheet is “a primer-coated liner sheet.” (Emphasis added.) The examiner did not address where these claim features are suggested by the prior art.

Specifically, McKillip nowhere mentions, discloses or suggests a primer coat between the adhesive 28 and the “liner sheet” 22. As an example, the words “primer” or “primer-coated” are not even used in McKillip. Rather, the adhesive is applied directly to the upper surface 37 of the “liner sheet” 22, as disclosed at col. 7, lines 35-47, and as shown in FIGS. 4 and 6.

The final Office Action does not state where McKillip discloses this “primer coat” or this “primer-coated” liner sheet, that McKillip has this primer coat or this primer-coated liner sheet or where there was a suggestion in the prior art for adding this primer coat or this primer-coated liner sheet to McKillip. Accordingly, withdrawal of these rejections is in order.

Rejection of Claim 314 is Defective and Must Be Withdrawn

In the Amendment dated February 21, 2008, claim 314 was amended to add the feature: “the ultraremovable adhesive providing only partial contact with the cardstock sheet construction and the partial contact preventing the ultraremovable adhesive from becoming permanent over time.”

(Emphasis added.) The final Office Action says only that claim 314 is rejected for the same reasons as in the Office Action dated November 1, 2007. By not considering and addressing the new feature, the rejection of claim 314 is defective and must be withdrawn.

Obviousness Rejections of Independent Claims 314 and 339 Are Traversed

Independent claim 314 includes an “ultraremovable adhesive that provides only partial contact with the cardstock sheet construction and the partial contact prevents the ultraremovable adhesive from becoming permanent over time.” (Emphasis added.) Independent claim 339 includes that the ultraremovable adhesive is a “suspension-polymer ultraremovable adhesive.” (Emphasis added.)

In the rejections of these claims on page 5 of the prior Office Action, it states “[t]he ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet (*col. 7, lines 35-47.*)” (Emphasis added.) No explanations were provided in the prior Office Action or the subject final Office Action: (a) as to why the McKillip adhesive was construed (“deemed”) to be an “ultraremovable” adhesive, (b) as to why the McKillip adhesive was construed to be a “suspension polymer” ultraremovable adhesive or (c) as to why the McKillip adhesive was construed to “provide only partial contact with the cardstock sheet construction” which “prevents the ultraremovable adhesive from becoming permanent over time.”

McKillip col. 7, lines 35-47, does not disclose that the “adhesive means 28” is an ultraremovable adhesive as would be understood by one skilled in the art from the present application and as has previously been discussed at length by Applicants in prior responses in this application. In particular, the meaning of “ultraremovable adhesive” is set forth in Dr. Ugolick’s Declaration filed on September 14, 2006 and whose entire contents are hereby incorporated by reference. An ultraremovable adhesive is a removable adhesive that does not become permanent over time.

In contrast, McKillip says that the adhesive means 28 is “preferably a pressure sensitive adhesive, such as acrylic based permanent adhesive or a removable rubber based adhesive – although

other types of conventional adhesives are also contemplated for use.” (Col. 7, lines 37-41.) These are not “suspension-polymer ultraremovable adhesives” nor are they “ultraremovable adhesives that do not become permanent over time,” Applicant respectfully submits. Furthermore, McKillip’s acrylic-based permanent adhesive is a permanent adhesive and not one which does not become permanent, and the “removable rubber based adhesive” is not a suspension polymer. Additionally, an ultraremovable adhesive is not a “conventional adhesive.”

First, Applicant is not aware of any law or Patent Office practice which allows an examiner to “deem” a prior art reference to be something which it is not. Second, Applicant on pages 22 and 23 of their earlier Amendment specifically pointed out that McKillip does not disclose a “suspension-polymer ultraremovable adhesive.” Third, the examiner in her final Office Action did not respond to or comment on Applicant’s arguments.

Accordingly, no *prima facie* case of obviousness has been made and withdrawal of the rejections of claims 314 and 339 is in order.

Dependent Claims

The dependent claims are patentable for at least the reasons for which their independent claims are patentable. Allowance thereof is thus in order.

Conclusions

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested, and allowance at an early date is solicited.

The examiner is invited to call the undersigned counsel for Applicant at counsel’s new phone number ((805) 230-1350 ext 244) to answer any questions or to discuss steps necessary for placing the subject application in condition for allowance.

Appl. Serial No. 09/872,353
Amendment Dated 10/28/2008
Response to Final Office action dated 5/28/2008

SoCal IP
Law Group LLP

The Commissioner is hereby authorized to charge any additional claim fees and any other fees which may be required, or credit any overpayment, to Deposit Account No. 503456. Should any such fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Date: October 28, 2008

Respectfully submitted,

Douglas N. Larson
Registration No. 29,401

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com